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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/511,073 02/23/00 MONDET

J WPB 29683C

Oliff & Berridge PLC  
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IM22/0809

EXAMINER

SERGEANT, R

ART UNIT

PAPER NUMBER

1711

DATE MAILED:

08/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/511,073

Applicant(s)

Mondet et al.

Examiner

Rabon Sergeant

Group Art Unit

1711



☒ Responsive to communication(s) filed on May 2, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 13-15 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 13-15 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/283,765

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The terminal disclaimer filed on May 2, 2001 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. 5,538,717 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujii et al ('881).

Fujii et al disclose aqueous thermoplastic urethane dispersions produced from diisocyanates, such as dicyclohexylmethane diisocyanate; polyester diols; a low molecular weight polyhydroxyl compound; and a dimethylolalkanoic acid. See abstract; column 4, lines 33+; and column 5.

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4. Though patentee discloses applicants' claimed polyester diol, patentee does so by way of specifying different diol and diacid reactants, some of which would have yielded polyesters outside the scope of those specified by the applicants; however, the position is taken that the reference teaches to one of ordinary skill that the use of the disclosed polyesters within the specified polyurethane formulations yield polyester polyurethanes suitable for water dispersible applications. Therefore, in the absence of a showing of criticalness attributable to the claimed polyester component, the position is taken that it would have been obvious to one, of ordinary skill in the art, seeking dispersible urethanes to select the disclosed reaction constituents from the teachings of the patentee, so as to arrive at the instant invention.

5. Despite applicants' argument that the instant polyester polyol is not disclosed by the reference, Fujii et al do, in fact, disclose polyester polyols, having the same molecular weight as applicants' polyol, which are derived from monomer components which correspond to those of applicants. See column 5, lines 7, 18, 20, 22, and 23. Furthermore, applicants' argument concerning the use of a two-step process is not understood, since the claims are not so limited.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/dh

July 17, 2001

  
**RABON SERGENT**  
**PRIMARY EXAMINER**